

REMARKS

i. **Status of the claims**

Claims 1-14, 28-32, and 34-37 are pending. Claims 15-27 and 33 were previously canceled.

ii. **The restriction requirement**

The Examiner required restriction, under 35 U.S.C. §§ 121 and 372, between Groups I, II, and III as these groups of inventions allegedly are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Group I: claims 1-4, 7-10, and 36 drawn to a macromonomer having vinylphenylpropyl as the terminated group.

Group II: claims 1-3, 5-10, and 36-37 drawn to a macromonomer having an oxetane as the terminated group.

Group III: claims 11-14, 28-32, and 34-35 drawn to a polymer.

Applicants hereby provisionally elect Group II (claims 1-3, 5-10, and 36-37) for examination with traverse, for the reasons that follow. Applicants also believe that the restriction requirement is in error as explained below.

iii. **Groups II and III should be rejoined because they share a common core structure**

Section 1850 at page 1800-60 to -61 of the Manual of Patent Examining Procedure (original 8th edition, published August, 2001) provides that

In applying PCT Rule 13.2 to . . . national stage applications under 35 U.S.C. 371, examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2 . . .

Hence, a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature.

In the present situation, therefore, Applicants believe that the claims of Groups II and III should be rejoined because those Groups share a common core structure. Specifically, the subject matter claimed in Group III is drawn to a polymer of the macromonomer of elected Group II. To clarify, claim 11 is to a "cross linked polymer formed by the polymerization of a macromonomer that has the structure claimed in claim 4 . . ." The macromonomer of claim 4 is terminated by a 3-methyloxetan-3-ylmethyl ether group. Accordingly, the common core structure that exists between Groups II and III is the oxetane terminated moiety. For this reason, Applicants respectfully request that Groups II and III be rejoined.

iv. The restriction requirement should have been based on the claim set accompanying the IPER instead of those that were presented in the original application

It appears that restriction has been made between the claims of the originally-filed application instead of those accompanying the IPER. Applicants append to this paper a copy of that marked-up "CLAIMS (as published)" document that was appended to the IPER dated August 25, 2000.

According to the numbering scheme of the IPER claim set, original claim 13, drawn to the oxetane-terminated polymer, was renumbered as claim 11. Original claim 13 depended from original claim 5, the oxetane-terminated macromonomer, but claim 5 had been renumbered as claim 4 in the IPER. Claim 11 of the IPER, therefore, does not correspond to claim 11 of the present restriction requirement.

Applicants respectfully request, therefore, that the Examiner reissue the restriction requirement and base any grouping of the claims on the correct, IPER-renumbered, claim set to avoid any ambiguity. In this respect, the Examiner is invited to contact the undersigned if a telephone conversation can expedite this, or any other, aspect of examination.

Respectfully submitted,

Date 1 December 2004

By S. A. Bent

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5404
Facsimile: (202) 672-5399

Stephen A. Bent
Attorney for Applicant
Registration No. 29,768